

Appin No. 09/721,862
Amdt. Dated December 2, 2004
Response to Office action of November 2, 2004

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REMARKS/ARGUMENTS

Claim Rejections – 35 USC §112

Claims 8-14 and 21-29 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The rejection is respectfully traversed.

The Examiner dismissed the applicant's previous amendment of the specification as adding "new matter," without providing any comment on the applicants' right to introduce into the specification material that was properly incorporated by reference in the application as filed. Therefore, the applicants have again attempted to amend the specification by copying, verbatim, material from a co-pending application that describes additional features of the same "netpage" printer that is described in the present specification. The applicants respectfully submit that such a practice is allowed under the patent regulations and does not add new matter.

The present invention concerns netpage printers as described in the specification as originally filed at page 8, beginning at line 22. Further, the specification as originally filed stated on page 2, lines 17-19, that "[v]arious methods, systems and apparatus relating to the present invention are disclosed in the following co-pending applications filed by the applicant or assignee of the present invention on 23 May 2000...." One of those U.S. applications, USSN 09/575,195, also describes netpage printers in detail and, in particular, on page 27, lines 13-14, states: "*This printer simultaneously prints cyan, magenta, yellow, black, and infrared inks as well as paper conditioner and ink fixative.*" The patent regulations authorize the copying of that sentence—that was properly incorporated by reference into the present application as filed—into the text of the present specification, which is what the applicants have done by the present amendment.

The Examiner's attention is respectfully directed to MPEP 608.01(p): "*Prior to allowance of an application that incorporates essential material by reference to a pending U.S. application, the examiner shall determine if the referenced application has been published or issued as a patent.... If the referenced application has not been published or issued as a patent, applicant will be required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application.*" (Emphasis added.)

Application No. 09/575,195, from which the material of the present amendment was copied, has not been published. Therefore please also find attached a declaration under 37 C.F.R. 1.132 stating that the amendatory material consists of the same material incorporated by reference in the referencing application. Thus no new matter has been added to the present specification by the present amendment.

Further support for the limitations included in present amended claim 8 is found in the specification as originally filed at page 5, line 16: "*In its preferred form, the netpage system relies on the production of, and human interaction with, netpages. These are pages of text, graphics and images printed on ordinary paper or other media, but which work like*

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interactive web pages. Information is encoded on each page using ink which is substantially invisible to the unaided human eye. The ink, however, and thereby the coded data, can be sensed by an optically imaging pen and transmitted to the netpage system."

Therefore, the applicants submit that there is now substantial correspondence between the present claims and the language of the specification. See, e.g., MPEP 1302.01: "It should be noted, however, that exact terms need not be used in *haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires substantial correspondence between the language of the claims and the language of the specification." In particular, there is substantial correspondence between the above language in the specification and the limitation of claim 8: "wherein the visible content and the invisible coded data are printed by the same printer substantially simultaneously."

Further, the limitations of the present claims are neither disclosed nor fairly suggested in the prior art cited by the Examiner. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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